

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed February 25, 2005. Claims 1-38 are pending in the Application. Applicant has amended Claims 1, 9, 17, 22, 28, 31, and 34. Applicant submits that no new matter has been introduced by these amendments. Applicant submits that the pending claims are patentably distinguishable over the cited references. Applicant, therefore, respectfully requests reconsideration and favorable action in this case.

Section 112 Rejections

The Office Action rejects Claim 31 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended Claim 31 as suggested by the Examiner. Reconsideration and favorable action are thus respectfully requested.

Section 103 Rejections

The Office Action rejects Claims 1, 6-9, 14-16, and 34-38 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,804,810 issued to Woolley et al. ("*Woolley*"). The Office Action also rejects Claims 2-4, 10-12, and 17-31 under 35 U.S.C. § 103(a) as being unpatentable over *Woolley* in view of U.S. Patent No. 5,742,237 issued Bledsoe ("*Bledsoe*"). Applicant traverses all rejections and all assertions therein.

Woolley discloses a method where some or all asset tags communicate with other tags in their vicinity to establish a communication network. Col. 16, Lines 58-65. This network is established through the use of a function of each tag that causes the tag to look for other tags in the vicinity. Col. 31, Lines 9-15. A neighborhood algorithm then provides for subsequent tags to further identify neighboring tags and establish a network of neighboring tags. Col. 49, Lines 2-45. A "netmaster" tag is then designated by identifying the tag with the highest identification number. *Id.*

Bledsoe discloses a system of tag monitoring that utilizes a grid of monitors to communicate with tags within range of the monitor. Col. 2, Lines 51-57. Tags in this system do not receive data, but periodically transmit without being polled by an interrogator. Col. 2, Lines

20-22. The transmissions are received by monitors and forwarded to a central computer to determine the location of the tag. Col. 2, Lines 23-27.

In order to establish a *prima facie* case of obviousness, three requirements must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge available to one skilled in the art, to modify a reference or combine multiple references; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all of the claim limitations. M.P.E.P. § 2143. In the present case, a *prima facie* case of obviousness cannot be maintained for Claims 1, 6-9, 14-16, and 34-38 for at least two reasons. First, *Woolley*, whether considered singly or in combination with information generally available to those of ordinary skill in the art at the time of the invention, fails to disclose all elements of the pending claims. Second, *Woolly* similarly fails to provide a suggestion or motivation to modify the reference. Furthermore, a *prima facie* case of obviousness cannot be maintained for Claims 2-4, 10-12, and 17-31 at least because the combination of *Woolley* and *Bledsoe*, whether considered alone or in combination with information generally available to those of ordinary skill in the art at the time of the invention, does not disclose all of the elements of the pending claims.

Claims 1, 6-9, 14-16, and 34-38 Are Allowable

As mentioned above, the Office Action rejects Claims 1, 6-9, 14-16, and 34-38 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,804,810 issued to Woolley et al. ("*Woolley*").

Woolley, whether considered singly or in combination with information generally available to those of ordinary skill in the art at the time of invention fails to disclose each and every element of Claims 1, 6-9, 14-16, and 34-38. For example, Independent Claim 1, as amended recites, "initializing each of a plurality of primary tags by loading each primary tag with a list identifying one or more linked tags associated with the primary tag". Applicant submits that this element at least is not disclosed, taught, or suggested by *Woolley*. The network system in *Woolley* establishes a communications network of linked tags based on proximity only and then assigns a "netmaster" tag based on identification numbers. In this disclosure, the netmaster tags do not have responsibility over the secondary tags defined by an initialized list as recited in

Claim 1. Instead they only communicate with neighboring tags as a result of the self-generating proximity-based network. Thus the primary tags are not analogous to the netmaster tags and are not disclosed by the reference.

Furthermore, *Woolley* does not suggest or motivate a modification of the reference. The M.P.E.P. sets forth a strict legal standard for finding obviousness based on a modification of references. According to the M.P.E.P., “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge [that was] generally available to one of ordinary skill in the art” at the time of the invention. M.P.E.P. 2143.01. The “fact that references can be combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination” or modification. *Id.* (emphasis in original). The Office Action does not provide the required motivation to modify the reference.

Furthermore, modifying the network communication system as disclosed in *Woolley* to teach the claimed limitations would render key features useless or inoperable. If a “proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” M.P.E.P. §2143.01. The network system disclosed in *Woolley* relies on a neighborhood algorithm to dynamically generate and modify existing network communications between asset tags and monitors. Modifying this reference by “initialization each of a plurality of primary tags by loading each primary tag with a list identifying one or more linked tags associated with the primary tag” as cited in Claim 1, would render useless the neighborhood algorithm disclosed by *Woolley*. Consequently, a *prima facie* case of obviousness cannot be maintained with respect to Claim 1. For at least this reason, Applicant respectfully requests allowance of Independent Claim 1 and its respective dependent Claims 2-8.

Independent Claims 9 and 34, as amended, are allowable for analogous reasons. Claims 10-16 each depend from independent Claim 9 and are thus patentable over the cited art for at least the reasons discussed above with regard to Claim 9. Claims 35-38 each depend from independent Claim 34 and are thus similarly patentable over the cited art for at least the reasons

discussed above with regard to Claim 34. Applicant respectfully requests reconsideration and allowance of these claims.

Claims 2-4, 10-12, and 17-31 Are Allowable

As mentioned above, the Office Action rejects Claims 2-4, 10-12, and 17-31 under 35 U.S.C. § 103(a) as being unpatentable over *Woolley* in view of U.S. Patent No. 5,742,237 issued Bledsoe ("*Bledsoe*").

A. Independent Claims 17, 22, and 28 Are Allowable

Independent Claims 17, 22, and 28 are allowable for reasons analogous to those previously discussed in regards to Claim 1. In rejecting these claims, the examiner asserts that the primary tags disclosed in Claims 17, 22, and 28 are analogous to the netmaster tags disclosed in *Woolley* and are thus disclosed by the reference. However, as established above, the netmaster tags of *Woolley* are not analogous to the primary tags as described in amended claims 17, 22, and 28, their use is not suggested or motivated by *Woolley*, and a modification of the reference would render key features useless or inoperable. This renders moot the Examiner's further reference to Bledsoe for the teaching of user notification. Consequently, a *prima facie* case of obviousness cannot be maintained with respect to Claim 17, 22, and 28. For at least these reasons, Applicant respectfully requests allowance of independent Claims 17, 22, and 28, as well as their respective dependent Claims 18-21, 23-27, and 29-31.

B. Claims 21, 26, and 27 Are Allowable

Claim 21 recites the use of a primary radio frequency tag comprised of a first receiver operable to receive the response message on a first frequency and a second receiver operable to receive a status request from a base station on a second disparate frequency. Claim 27 similarly recites an asset monitor system utilizing a primary tag comprising two receivers each configured to receive on disparate frequencies. Claim 26 recites a base station that is configured to transmit and receive at disparate frequencies in communicating with primary tags.

In rejecting these claims, the Examiner references both *Woolley* and *Bledsoe*, but cites only *Woolley* as disclosing the use of a base station and tags that communicate via integrated transmitters and receivers. However, the Examiner concedes that the references are silent on the

use of first and second disparate frequencies and respective first and second (multiple) receivers as recited in the claims. Therefore, these elements remain undisclosed. Instead, the Examiner provides only the conclusory argument that the value of utilizing separate, disparate communications frequencies is well known in the communications art and, therefore, utilizing disparate frequencies and multiple receivers within tags to separate response messages from base station status request signals, as recited in Claims 21 and 27, is obvious to one of ordinary skill in the art. The Examiner similarly concludes that the use of disparate frequencies within a base station to separate transmitting and receiving signals, as recited in Claim 26, is also obvious. The Examiner cannot rely on a general statement that a limitation is "well known." If the Examiner is relying on "common knowledge" or "well known" art to provide the missing limitations, the Examiner is requested to produce a reference in support of his position as required by M.P.E.P. § 2144.03. Otherwise, if the Examiner is relying on personal knowledge to supply the required teachings, Applicant respectfully requests that the Examiner produce an affidavit supporting such facts as required by M.P.E.P. § 2144.03. Since such a reference or affidavit has not yet been provided, Applicant respectfully requests reconsideration and allowance of Claims 21, 26, and 27.

C. Claims 24 and 29 Are Allowable

Claim 29 recites an asset monitoring system wherein the primary and intermediate primary tags are active tags and the secondary tags are passive tags. Claim 24 similarly recites a system wherein one or more secondary radio tags are passive tags. The Examiner cites *Woolley* as describing a system that utilizes both active and passive tags. However, the first sentence of the description in *Woolley* explicitly states, "this invention relates to managing assets equipped with active electronic tags". Col. 1, Lines 6-7. This is further reinforced in Col. 16, 32-35, which describes the preferred embodiment of a collection of active asset tags as depicted in Fig. 2. It is important to note that using active asset tags appears to be a necessary feature of the method disclosed by *Woolley* in order to accommodate the neighborhood algorithm and self generating communications network.

In rejecting these claims, the Examiner cites a passage of *Woolley* that states, "the asset tags are either battery powered or powered by an external source". Col. 16, Lines 65-66. The examiner then incorrectly equates power source with active and passive capabilities. Active asset tags are those tags that can initiate communications or other functions while passive tags can

only respond when activated by an interrogator. Col. 1, Lines 23-25. This is independent of power source and thus the cited disclosure is not related to whether the disclosed tags are active or passive. For at least these reasons, Applicant respectfully requests allowance of Claims 24 and 29.

Allowable Subject Matter

Applicant notes with appreciation the allowance of Claims 32-33. Furthermore, the Examiner indicates that Claims 5 and 13 are objected to but would be allowable if rewritten in independent form. However, since Claims 5 and 13 depend from independent Claims 1 and 9, which are allowable for the reasons provided above, Applicant has not amended Claims 5 or 13. Favorable action is requested.

CONCLUSION

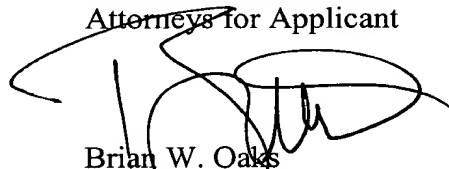
Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all the pending claims.

If the present application is not allowed and/or if one or more of the rejections is maintained, Applicant hereby requests a telephone conference with the Examiner and further request that the Examiner contact the undersigned attorney to schedule the telephone conference.

Applicant believe no fees are due. However, the Examiner is authorized to charge any other fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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